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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/600,371

06/23/2003

Gholam A. Peyman

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08/01/2006

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EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,371

Applicant(s)

PEYMAN, GHOLAM A.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 20, 21, 32, 33, 36-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-19, 22-31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The Applicant's remarks with regard to the species election are generally persuasive. Accordingly, claims 1-6, 9-19, 22-31, 34, and 35 are currently under examination, with claims 7, 8, 20, 21, 32, and 33 being withdrawn as being directed to non-elected species. However, it is not seen how newly added claims 36-49 are supported by *any* originally disclosed embodiment in that "converging and diverging lenses being *offset* from each other in a direction perpendicular to the optical axis" (e.g., claim 36, lines 5-6; emphasis added) is not described or suggested in the application as filed. Moreover, the Applicant has failed to particularly point out the support in the original disclosure for each of the newly added claim limitations (MPEP §§ 714.02 and 2163.06). Therefore, claims 36-49 are withdrawn as being directed to a non-elected (and nonexistent) embodiment or species.

The disclosure is objected to because of the following informalities: Paragraph **0029** appears to be inaccurate in that only one plus lens is depicted in Figure 8. On page 9, second to last line, "mucopolysaccharide" is misspelled. Appropriate correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claims because the examined application claim is either anticipated by, or would have been obvious over, the reference claims (e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 9-19, 22-31, 34, and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 11/038,320. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of present claim 1 and others are set forth in or are implicit from copending claims 15, 16, 20, 37, 41, and others. The variants of instant claims 9, 10, 12, and others were known to the ordinary practitioner and would have been obvious in order to provide appropriate prescriptions for different levels of myopia, hyperopia, presbyopia, and/or astigmatism. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6, 9-19, 22-31, 34, and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/455,788. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present features are found in or would have been obvious from such copending claims as 23-25, 30, 36, 37, and 40, for reasons similar to those presented above. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. In claim 35, line 3, “a second lens” (emphasis added) renders the claim confusing as to the scope because claim 14 has been amended to additionally recite “a second lens” (line 4).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Peyman et al., US 6,197,057 B1: Figures 18-21. Regarding claim 1, lens **116** has a high minus portion *capable* of supplementing an artificial lens implanted in the cornea, for example (whether or not such was the intent), and lens **142** is adapted to be implanted in series with lens **116** to create a telediopic lens system (abstract; column 6, lines 57-64; column 8, lines 45-54; etc.). Regarding claims 4-6, the haptics **138** and **140** (Figure 21) are *capable* of securing the lens **116** to the iris via sutures or the like (whether or not such was the intent). It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138). MPEP 2106, section II. C., explains that language which suggests or makes optional but “does not limit a claim to a particular structure does not limit the scope of a

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claim or claim limitation”; “examples of language that may raise a question as to the limiting effect of the language in a claim” are “adapted to” and “adapted for” clauses.

Claims 9-12, 14-19, 22-31, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman et al., US 6,197,057 B1. Regarding claims 9-12 and others, the lens **142** having at least one minus zone, at least one plus zone, and/or a toric zone (configurations well known in the art) would have been obvious in order to treat presbyopic patients having myopia, hyperopia, and/or astigmatism. Regarding claims 14, 31, and 35, operating on an eye with a pre-existing artificial corneal lens would have been obvious for patients additionally having cataracts and macular degeneration. Regarding claims 17-19, securing the lens **116** to the iris would have been obvious to the ordinary practitioner in order to better stabilize the lens. Regarding claim 30, the lenses are inserted into the anterior chamber just prior to their being inserted into the posterior chamber (during the surgical procedure). Regarding claim 31, lens **116** inherently possesses a slightly positive outer zone by virtue of its curved form, which contributes to the refractive convergence of light rays.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and sometimes on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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A handwritten signature in black ink, appearing to read 'Dave Willse', with a stylized, cursive script.

Dave Willse
Primary Examiner
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